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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,117	12/09/2003	Sugio Makishima	2091-0304P	4321
2292 7590 06/04/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
BEMBEN, RICHARD M				
ART UNIT		PAPER NUMBER		
2622				
NOTIFICATION DATE		DELIVERY MODE		
06/04/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/730,117

Applicant(s)

MAKISHIMA ET AL.

Examiner

RICHARD M. BEMBEN

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 6-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/219,123.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 2, 4 and 6-11 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. The following is a quotation of the sixth paragraph of 35 U.S.C. 112:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, materials, or acts in support thereof, and such a claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

5. **Claims 1 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment filed 6 March 2009 amended claims 1 and 9 to include the limitation "prior to the digital image data being read out of the storage medium for printing". This limitation is not supported by applicant's specification. On the contrary, in several places applicant's specification

uses the past tense to describe when an image with associated print-specifying information is displayed, e.g. "an image is displayed in correspondence to an actually *printed* state" (page 4, lines 18-19) and "[u]sers are therefore readily able to recognize the number of print frames *that are printed*" (page 7, lines 22-24).

Further, the amendment filed 11 July 2008, which amended claims 1 and 9 to require that the digital image data is "stored as fixed image data in a storage medium", is also not supported by applicant's specification. As originally filed, applicant's specification only discusses a storage medium in the "Description of the Related Art" and never discloses a storage medium as part of applicant's invention in any of the "Summary of the Invention", the "Detailed Description", the Claims as originally filed, or the Drawings.

Therefore, neither applicant's current amendment (filed 6 March 2009) nor applicant's previous amendment (filed 11 July 2008) are supported in applicant's specification. Dependent claims 2, 4, 6-8, 10 and 11 are similarly rejected due to their dependencies.

6. Applicant's means-plus-function claim language in claims 1, 2, 4 and 6-8 invoke 35 U.S.C. 112, sixth paragraph. Therefore:

"display means" will be construed to cover a monitor (page 10, line 4) and equivalents thereof; and

"printing-specifying information setting means" will be construed to cover a release button, an increment button, a decrement button, an execution button, a mode setting dial (page 10, line 21 – page 11, line 5), and equivalents thereof.

7. 35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language “shall be construed to cover the corresponding **structure...described in the specification** and equivalents thereof.” “If one employs means plus function language in a claim, **one must set forth in the specification an adequate disclosure showing what is meant by that language.** If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.” In re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc). The proper test for meeting the definiteness requirement is that **the corresponding structure (or material or acts) of a means (or step)-plus-function limitation must be disclosed in the specification itself in a way that one skilled in the art will understand what structure** (or material or acts) will perform the recited function. See Atmel Corp. v. Information Storage Devices, Inc., 198 F.3d 1374, 1381, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999). See MPEP 2181 (*emphasis added*).

Applicant's specification does not set forth the requisite structure of the means-plus-function limitation in claim 1. For example, the specification does not set forth the structure of the “control means”.

Claim 1 is therefore rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use

the invention. Undue experimentation would be required in order for one skilled in the art to practice applicant's invention because the specification does not disclose the corresponding structure of the means-plus-function limitations.

Further, claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Refer to the reasoning above.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,522,354 issued to Kawamura et al., hereinafter "Kawamura".

Regarding **claim 1**, Kawamura discloses a digital camera comprising:

display means for displaying digital image data of a photographed image (c. 4, ll. 16-18, c. 5, ll. 32-41 and Figures 2 & 3, "19"), the digital image data having been acquired by photographing and stored as a fixed image data in a storage medium (c. 4, ll. 19-23, 63-67, c. 5, ll. 32-34, Figure 2, "21");

printing-specifying information setting means for setting printing specifying information for said digital image data, the printing specifying information being used during printing (c. 5, ll. 42-46 and Figure 2, selection switches "35", "36" and confirmation switch "37" which specify transfer to printer: c. 6, ll. 36-37);

and control means for displaying said digital image data for which said printing-specifying information was set onto said displaying means so that said printing-specifying information corresponds to said digital image data (c. 6, ll. 51-58 and Figure 6, images 1 and 3 have "PC" icon, which can signify printer) and for

displaying digital image data with no printing-specifying information onto said display means, such that said digital image data for which said printing-specifying information was set and said digital image data with no printing-specifying information are discriminated from each other when they are displayed at the same time on said displaying means (Figure 6, images 1 and 3 have print icon, images 2 and 4-6 do not) prior to the digital image data being read out of the storage medium for printing (Refer to c. 9, ll. 50-60; in the situation where the recorded information is to be transferred to external equipment a plurality of times, "the number of transfers may be displayed in the middle of the corresponding icon" and "the operator is informed of the number of transfers of the recorded information". Therefore, whether the number of transfers is displayed in the middle of the icon before all of the transfers or whether the number is updated as the transfers complete, the icon is displayed prior to recorded information (image data) being read out of the storage medium for printing).

Claim 9 is a method claim corresponding to apparatus claim 1. Therefore, claim 9 is analyzed and rejected as previously discussed with respect to claim 1. Note that claim 9 does not include the limitation to display "at the same time" required by claim 1.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2, 6, 7, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura in view of US Pub. No. 2004/0201764 filed by Honda et al., hereinafter "Honda".

Regarding **claim 2**, Kawamura discloses a digital camera comprising a display that displays print information as required by claim 1 (refer to the rejection of claim 1). However, Kawamura does not disclose that said printing-specifying information being used during printing includes a number of print sheets, specification of an index image, printing size, surface treatment, presence of a white frame, trimming and/or attribute data (note that this limitation will be analyzed in the alternative form).

Honda discloses a digital camera comprising a display that displays print information ([0078] and Figures 4, 30A, 30C, 31 & 32A-B) wherein the printing-specifying information being used during printing includes a number of print sheets (Figures 30A, 30C, 31 & 32A-B). Therefore, it would have been obvious to one of

ordinary skill in the art at the time of the invention that the print-specifying information includes the number of print sheets as disclosed by Honda in the digital camera disclosed by Kawamura such that a user can produce one or several hardcopies of a digital image.

Regarding **claim 6**, Kawamura discloses a digital camera comprising a display that displays print information as required by claim 1 (refer to the rejection of claim 1). However, Kawamura does not disclose that said control means is means for displaying a total number of print sheets on said display means, when said printing-specifying information being used during printing includes a number of print sheets.

Honda discloses a digital camera comprising a display that displays print information ([0078] and Figures 4, 30A, 30C, 31 & 32A-B) comprising a control means for displaying a total number of print sheets on said display means, when said printing-specifying information being used during printing includes a number of print sheets (Figures 30A, 30C & 32A-B disclose total number of print sheets per frame; Figure 31 discloses total number of all frames). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to display the total number of print sheets as disclosed by Honda on the display disclosed by Kawamura such that a user is informed of how many images will be printed.

Regarding **claim 7**, Kawamura discloses a digital camera comprising a display that displays print information as required by claim 1 (refer to the rejection of claim 1).

However, Kawamura does not disclose that said control means is means for displaying a number of print frames onto said display means, when said printing-specifying information being used during printing includes a number of print sheets.

Honda discloses a digital camera comprising a display that displays print information ([0078] and Figures 4, 30A, 30C, 31 & 32A-B) comprising a control means for displaying a number of print frames onto said display means, when said printing-specifying information being used during printing includes a number of print sheets (Figures 30A, 30C & 32A-B disclose total number of print sheets per frame; Figure 31 discloses total number of all frames). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to display the total number of print frame as disclosed by Honda on the display disclosed by Kawamura such that a user is informed which and how many images will be printed.

Claim 10 is a method claim corresponding to apparatus claim 2. Therefore, claim 10 is analyzed and rejected as previously discussed with respect to claim 2.

Regarding **claim 11**, Kawamura discloses the method to operate a digital camera required by claim 9 (refer to the rejection of claim 9). However, Kawamura does not disclose displaying a sum of digital image frames displayed.

Honda discloses a digital camera and method of operating a digital camera comprising a display that displays print information ([0078] and Figures 4, 30A, 30C, 31 & 32A-B) wherein a sum of digital image frames is displayed (Figure 31 discloses total

number of all frames). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to display a sum of digital image frames as disclosed by Honda on the display disclosed by Kawamura such that a user can view the selections he/she made.

12. Claims 4/1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura in view of Hanzawa (U.S. Patent No. 5,506,661).

Regarding **claim 4/1**, Kawamura discloses a digital camera comprising a display that displays print information (refer to the rejection of claim 1). However, Kawamura does not disclose that control means is means for displaying only the printing-specifying data for which said printing-specifying information was set, in displaying said digital image data onto said display means.

Hanzawa discloses an imaging apparatus comprising a display that displays print information (c. 3, ll. 23-25; c. 4, ll. 40-63; Fig. 2). Hanzawa further discloses that only the printing-specifying data is displayed on said display means (Figs. 2, 5, 6, 8). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to only display print-specifying data as disclosed by Hanzawa on the display means disclosed by Kawamura in order to simplify the display or save power.

Regarding **claim 8**, Kawamura discloses a digital camera comprising a display that displays print information (refer to the rejection of claim 1). However, Kawamura does not disclose that control means is means for displaying a printing price value

corresponding to the number of print sheets onto said display means, when said printing-specifying information being used during printing includes a number of print sheets.

Hanzawa discloses an imaging apparatus comprising a display that displays print information (c. 3, ll. 23-25; c. 4, ll. 40-63; Fig. 2). Hanzawa further discloses that the display displays a printing price value corresponding to the number of print sheets onto said display means, when said printing-specifying information during said printing includes said number of print sheets (c. 4; ll. 40-63; c. 6, l. 3 – c. 7, l. 28; Figs. 2, 5, 6, 8). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to display a printing price value corresponding to the number of print sheets as disclosed by Hanzawa on the display means disclosed by Kawamura in order to inform the customer of the printing price (which is well-known at photo kiosks and the like).

13. Claims 4/2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura in view of Honda in further view of Hanzawa (U.S. Patent No. 5,506,661).

Regarding **claim 4/2**, Kawamura in view of Honda discloses a digital camera comprising a display that displays print information (refer to the rejection of claim 2). However, Kawamura in view of Honda does not disclose that control means is means for displaying only the printing-specifying data for which said printing-specifying information was set, in displaying said digital image data onto said display means.

Hanzawa discloses an imaging apparatus comprising a display that displays print information (c. 3, ll. 23-25; c. 4, ll. 40-63; Fig. 2). Hanzawa further discloses that only the printing-specifying data is displayed on said display means (Figs. 2, 5, 6, 8). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to only display print-specifying data as disclosed by Hanzawa on the display means disclosed by Kawamura in view of Honda in order to simplify the display or save power.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RICHARD M. BEMBEN whose telephone number is (571)272-7634. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RMB

/David L. Ometz/
Supervisory Patent Examiner, Art Unit 2622